



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,440	12/22/2000	Raymond Wheeler	NEOM0003	8419
22862	7590	05/18/2004	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			MARTINELL, JAMES	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,440

Applicant(s)

WHEELER, RAYMOND

Examiner

James Martinell

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/22/00.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1631

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-10, 12-14, 25-27, 30-38, 40-42, and 53-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague, indefinite, and incomplete.

- (a) The recitation of "preprocessing" (claims 2 and 30) is vague and indefinite because the term is not defined in the application, nor does it have an art-recognized meaning. Thus, the metes and bounds of the claims are not clear.
- (b) The recitation of "filtering" (claims 2 and 30) is vague and indefinite because the term is not defined in the application, nor does it have an art-recognized meaning. Thus, the metes and bounds of the claims are not clear.
- (c) The recitation of "highly similar alignments" (claims 6 and 34) is vague and indefinite because the instant application does not distinguish between highly similar alignments and non-highly similar alignments.
- (d) The recitation of "there is a filtering step" (claims 10 and 38) is vague and indefinite because it is not clear whether the filtering step is actually carried out.
- (e) The recitation of "shorter alignments" (claims 12 and 40) is incomplete because this is a comparative term with no frame of reference.
- (f) The recitation of "similar alignments" (claims 13 and 41) is vague and indefinite because the instant application does not distinguish between similar alignments and non-similar alignments.
- (g) The recitation of "widest possible soft end points" is vague and indefinite because it is not clear what the term means, nor is it clear what the metes and bounds of the claims are.

Art Unit: 1631

- (h) The recitation of widest possible among all of similar alignments" (claims 14 and 42) is vague and indefinite because it is not clear what the term means, nor is it clear what the metes and bounds of the claims are.
- (i) The recitation of "if there are no conflicts" (claims 25 and 53) is vague and indefinite because it is not clear what the passage means.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed process steps (*e.g.*, claims 1-28) are limited to data manipulation and do not result in a tangible, concrete, and useful result. Thus, the claims are drawn to non-statutory subject matter (see MPEP 2106). Likewise, the apparatuses for running non-statutory process steps (*e.g.*, claims 29-56) are drawn to non-statutory subject matter.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-6, 15, 16, 28-34, and 43-45 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Mironov et al (Genome Res. 9: 1288 (1999)). (The USPTO has determined *via* PubMed at NLM that the December 1999 issue of Genome Research (volume 9, number 12) was available to the public on December 30, 1999.) The instant claims describe no more than the alignment methods (and apparatuses) described in the reference (*e.g.*, see pages 1288-1289).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719. The fax phone number for Examiner Martinell's desktop workstation is (571) 273-0719. The examiner works a flexible schedule and

Art Unit: 1631


can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-0722.

PLEASE NOTE THE NEW FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.


James Martinell, Ph.D.
Primary Examiner
Art Unit 1631
5/14/04